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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,594	07/18/2003	Ralf Wichmann	07244-00135-US	4310

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CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON, DE 19899

EXAMINER	
LE, HOA VAN	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,594	WICHMANN ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *5-8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 9-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ---.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to Papers filed on 08 November 2004.

I. Applicants state on the record that the amendments to the claims would overcome the rejections on the record.

II. Claims (two claim 4) are rejected under 35 U.S.C. 112; second paragraph, as being indefinite.

There are claim 4 with "4.cancel" and claim 4 with "4.(original)".

There is required that it is only one claim 4.

III. Dependent claim 4 with "4.(original)" is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

It is not further limited independent claim 1.

IV. Dependent claims 1-3, 4 with "4.(original)" and 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite or double inclusion.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

"such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, the above claims recites the broad recitation "at least 0.02 mol" or '0.06 mol of a colour...", and the claims also recites "at least 50 mmol of a colour...".

V. Claims 1, 2, 4 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al (5,998,111).

Abe et al disclose and teach a single-part color developing concentrate having a pH value of 10 or more on col.31:36-40 and comprising from up to 200 mmol of a color developing agent on col.22:46, from about 55 g/l of a hydroxylamine containing antioxidant on col.40:63-64 and up to 15 g/l of an non-ionic surfactant of the general formula (SI) on col.9:24, surfactants SI(1-52) and 20:17-18 and TABLE 2 at Sample No. 2 and 6. The concentrate is diluted to about 5 times with water before use on col.42:6-10. Since Abe et al disclose and teach the limitations of the claims, they are found to be anticipated by Abe et al.

VI. Claims 1-4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al (5,998,111) considered in view of Papai (2002,0150845).

Abe et al disclose, teach and suggest a single-part concentrate color developing composition having a pH value of 10 or more on col.31:36-40 and comprising from up to 200 mmol of a color developing agent on col.22:46, from about 55 g/l of a hydroxylamine containing antioxidant on col.40:63-64 and up to 15 g/l of an non-ionic surfactant of the general formula (SI) on col.9:24, surfactants SI(1-52) and 20:17-18 and TABLE 2 at Sample No. 2 and 6. The composition is diluted to about 5 times with water before use on col. 42:6-10. Since Abe et al disclose, teach and suggest the limitations of the claims 1,2 4 and 11, they are found to be rendered prima facie obvious by Abe et al. (1) The language "concentrate" as selected by applicants has been considered but has and is given a little to no patentable value since "0.02 mol...per liter" or "50mmol...L" or "0.06 mol...per liter" as broadly claimed is well below amounts of ready-to-use amounts of a color developing agent as selected by one having ordinary skill in the art. Please especially the submitted and applied references on the record. (2) The newly added language "where in a concentrate is a preperation...to produce a ready-to-use" is considered as an added instruction or procedure or step just before or during use the claimed material. It has and is given a little to no patentable value in the instant material claims. It will be given full values in a process for using a material claim only since instantly claimed material does not have to dilute and used right away. But it can be traded, sold and brought in an undiluted form as broadly claimed. Should applicants disagree, they are urged to show or provide a convincing evidence to the contrary.

With respect to claim 9, the color developing agent is not always in a sulfate salt form. Please see Abe et al at col.22:36-37 with no salt or salts other than sulfate being known in the art for the same or about the same result of developing an a color image.

With respect to claim 3, "CD-4" color developing agent in no salt form is not taught in Able et al. Please see Papai at paragraphs [0010] and [0025] "CD-4" in free base being known in the art for the same or about the same result of color developed images and for the advantage of no sulfate precipitation. The use of up to 100 g/l of the "CD-4" in free base is disclosed, taught and suggest in paragraph [0020].

Since the above references are all related to high concentration of color developing agent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use "CD-4" in free base form from Papai in Abe et al developer concentrates for the desired advantage of obtaining the same or about the same color developed images and no sulfate precipitation as disclose, taught and suggest by Papai.

VII. Claims1-4 and 9-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikoshiba et al (6,713,243) considered in view of Papai (2002,0150845).

Mikoshiba et al disclose, teach and suggest high (col.96:58-59) and low (95:45-47) concentrations of a color developing agent containing color developing compositions having an alkaline pH on col.95:49-50 and comprising high and low concentrations of a color developing agent as cited above, a requisite amount of nonionic surfactant on col.95:33-34 and 96:46-48, a requisite amount of antioxidants on col.95:42-44 and 96:44-46, an optical brightener on col.95:40-42 and 96:53-54, less than 0.1 mol of sulfonate ions. There is no disclosure, teaching or suggestion of any undissolved component, or precipitation or multiphase or not homogeneous (It should be noted that for any argument with respect to a property of a material, the law required that applicants must provide a factual evidence to support in accordance with the

authority stated in In re Schreiber, 44 USPQ2d 1429 states that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart...169 USPQ 226, 228...Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart...where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject mater may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." A statement or argument alone may have and be given a little to no value because it is not factual evidence). (1) The language "concentrate" as selected by applicants has been considered but has and is given a little to no patentable value since "0.02 mol...per liter" or "50mmol...L" or "0.06 mol...per liter" as broadly claimed is well below amounts of ready-to-use amounts of a color developing agent as selected by one having ordinary skill in the art. Please especially the submitted and applied references on the record. (2) The newly added language "where in a concentrate is a preperation...to produce a ready-to-use" is considered as an added instruction or procedure or step just before or during use the claimed material. It has and is given a little to no patentable value in the instant material claims. It will be given full values in a process for using a material claim only since instantly claimed material does not have to dilute and used right away. But it can be traded, sold and brought in an undiluted form as broadly claimed. Should applicants disagree, they are urged to show or provide a convincing evidence to the contrary.

With respect to claim 2, "0.06 mol " color developing agent is not taught in Mikoshiba et al. Please see Papai at paragraphs [0020] with up to 100 g/l of a color developing agent being disclosed, taught and suggested.

With respect to claim 3, "CD-4" color developing agent in no salt form is not taught in Mikoshiba et al. Please see Papai at paragraphs [0010] and [0025] "CD-4" in free base being known in the art for the same or about the same result of color developed images and for the advantage of no sulfate precipitation. The use of up to 100 g/l of the "CD-4" in free base is disclosed, taught and suggest in paragraph [0020] and claim 9.

With respect to claims 12 and 15, "two or more liquid phases" is not taught in Mikoshiba et al. Please Papai at paragraphs [0019], [0024] and claim 9 for the teaching and suggestion of adding a non-water-soluble solvent to obtain a multiphase system.

Since the above references are all related to high concentration of color developing agent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use "CD-4" in free base form from Papai in Abe et al developer concentrates for the desired advantage of obtaining the same or about the same color developed images and no sulfate precipitation and multiphase system with an organic solvent as top layer to avoid an oxidation of a color developing agent in under layer for the reasonable expectation of obtaining a stable color developing composition.

VIII. Applicant's arguments filed 08 November 2004 have been fully considered but they are not persuasive.

In view of applicants' amendments and arguments, the rejections on the record in the previous Office action mailed 03 August 2004 have been withdrawn.

The above rejections over the prior art are new.

IX. Chen et al (6,387,067) is cited to show that a concentrate is known to be contained in a package for use in an automatic feeding color photographic processor. However, "package to be used for processing machine with automatic docking procedure" in claim 14 has not been found.

X. Abe (6,020,113) is cumulative the above applied primary references.

XI. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

XI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
16 December 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le